DETAILED ACTION

Claims 1-10 are pending in the application.

The rejection of the claims over Aono et al. {JP 10-195056} under 35 USC 103 has been withdrawn. Upon reconsideration, the teaching in Aono et al. is broad and would not lead one skilled in the art toward the compounds of the instant claims. Therefore, arguments pertaining to Aono et al. will not be addressed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Karjalainen et al.** {WO 97/12874}, taken alone, or Karjalainen et al. in view of **Huhtala et al.** {WO 01/051472}.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicant claims imidazole compounds. **Karjalainen et al.** (see entire document; particularly pages 1-4, 11 and 12; and especially Example 15 on page 30) teach imidazole compounds that are structurally similar to the instant claimed compounds.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art. Further, **Huhtala et al.** (page 8, last full paragraph) teach the interchangeability of esters of aliphatic and aromatic alcohols {i.e., the -C(=O)R group in instant formula (I)}.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., treating glaucoma).

One skilled in the art would thus be motivated to prepare products embraced by the prior art, especially in view of the teachings in Huhtala et al., to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in treating, for example, glaucoma, psychiatric and cognition disorders, etc. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

Response to Arguments

Applicant's arguments filed January 30, 2008 have been fully considered but they are not persuasive. Applicant argues that Karjalainen et al. fail to teach each and every element of the present claims since not one of R_6, R_7 or R_8 can be the presently claimed functional group –OCOR.

In response, it is disagreed that not one of R_6, R_7 or R_8 can be the presently claimed functional group –OCOR in Karjalainen et al. Karjalainen et al. teach the compounds or a pharmaceutically acceptable ester or salt of their compounds (page 1, lines 19-20; and page 2, line 10). Karjalainen et al. state the following which has been reproduced from page 4, lines 25-28 of Karjalainen et al.

> maleates, citrates, benzoates, salicylates, ascorbates. Furthermore, compounds wherein one or more of R_4 to R_8 is a hydroxy group form esters and salts with alkali metals and alkaline earth metals. Typical esters include the lower alkyl esters, such as the methyl, ethyl and propyl esters.

Therefore, anyone of R_6, R_7 or R_8 in Karjalainen et al. can represent the presently claimed -OCOR functional group.

Applicant argues that: (1) applying Huhtala et al.'s teachings to Karjalainen et al. would not change a principle function of Karjalainen et al. and that one of skill in the art would have no reason to combine the teachings of Huhtala et al. and Karjalainen et al.; (2) not one of the substituents of R_6 in Huhtala et al. include the presently claimed –OCOR group; and (3) even if the disclosure at page 8, last full paragraph, would provide a reason to one of skill in the art to substitute a R_6 hydroxy group with an ester, the rest of the Huhtala et al. disclosure has been ignored since the bulky $(CR_2R_3)_r$ group in Huhtala et al. must be present and does not overlap with the compounds of Karjalainen et al.

All of Applicant's arguments have been considered but have not been found persuasive. Applicant argues

that applying Huhtala et al.'s teachings to Karjalainen et al. would not change a principle function of Karjalainen et al. and that one of skill in the art would have no reason to combine the teachings of Huhtala et al. and Karjalainen et al. In response, Karjalainen et al. and Huhtala et al. teach imidazole compounds that are structurally similar to each other. Each of Karjalainen et al. (page 1, lines 9-12) and Huhtala et al. (page 14, second paragraph) teach that their compounds are useful in treating psychiatric and cognition disorders. Therefore, combining the teachings from the two references is proper.

Applicant also argues that not one of the substituents of R_6 in Huhtala et al. include the presently claimed –OCOR group. In response, as with the Karjalainen et al. reference, the R_6 in Huhtala et al. can represent a hydroxy group (page 3, line 2) and the hydroxy group (-OH) may form esters as discussed on

page 8, last full paragraph. Therefore, Huhtala et al. do teach the presently claimed –OCOR group.

Applicant argues that even if the disclosure at page 8, last full paragraph, would provide a reason to one of skill in the art to substitute a R_6 hydroxy group with an ester, the rest of the Huhtala et al. disclosure has been ignored since the bulky $(CR_2R_3)_r$ group in Huhtala et al. must be present and does not overlap with the compounds of Karjalainen et al.

In response, Huhtala et al. is a secondary reference and as such is not required to have all of the elements of the present claims or the primary reference. The test for combining references is not what individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (1971). While a deficiency in a reference may overcome a rejection under 35 U.S.C. § 103, a reference is not overcome by

pointing out that a reference lacks a teaching for which other references are relied. *In re Lyons*, 150 U.S.P.Q. 741, 746 (C.C.P.A. 1966).

Additionally, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Huhtala et al. was relied on to show the various types of esters formed from the hydroxy groups. Huhtala et al. teach the following (reproduced from page 8, last full paragraph) concerning the esters formed.

> The compounds of the invention can form acid addition salts with both organic and inorganic acids well known in the field of pharmaceuticals. Typical acid addition salts are e.g. chlorides, bromides, sulfates, nitrates, phosphates, sulfonates, formates, tartrates, maleates, citrates, benzoates, salicylates, ascorbates. Furthermore, in the compounds of the invention, wherein R_6, R_8 and/or the optional substituent at the ring moiety as R_1 is OH, the said –OH functionality may form esters with pharmaceutically acceptable acids which are conventional in the field of pharmaceuticals and which retain the pharmacological properties of the free form. Examples of such esters include esters of aliphatic or aromatic alcohols, e.g. lower alkyl esters, e.g. methyl, ethyl and propyl esters.

For all the reasons given above, the rejection is deemed proper and therefore, the rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of

this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system,

see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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June 12, 2008